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REMARKS

1. Status of the Claims

Claims 1 – 13, 15 – 34, and 37 - 48 are pending; claims 14, 35, and 36 are cancelled.

2. Rejection of Claims 3, 4, 24 and 25 under 35 USC §112, second paragraph

The Office Action states the use of the terms "disproportionate amount of recent publicity" and "little publicity" are unclear. These claims have been amended and are believed to meet the requirements of 35 USC §112.

3. Rejection of Claims 1-4, 6-11, 14-25, 27-32, and 35-42 under 35 USC §101

These claims were rejected as being directed to non-statutory subject matter. The office action asserted that the claims were "not within the technological arts." Independent claims 1 and 22 have been amended to include the recitation "that is processed by a computer," more explicitly placing them within the technological arts. The claims are believed to be in compliance with the statutory requirements of 35 USC §101.

4. Rejection of Claims 1-16, 18-20, 22-37, 39-41 and 43-48 under 35 USC §102(e)

These claims stand rejected as being anticipated by Reese, U.S. Patent No. 6,236,980 B1 ("Reese"). The Applicants respectfully traverse these rejections.

The Reese patent is concerned with the problem of helping investors sift through the vast blizzard of stock recommendations provided by various publications and analysts (col. 2, lines 40 – 57). Put another way, it purports to answer the question "should I listen to this person's advice that I buy (or sell) shares of stock in the XYZ Corporation?" To that end, it utilizes a number of analytical tools and historical data to summarize the outcome of previous advice offered by an analyst or publication.

The present invention addresses an entirely different sort of question to which an entirely different sort of answer is called for. Is a business opportunity or technology worth pursuing and, if so, what is the best means of pursuit – by adopting it as one's own,

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partnering with a vendor, or by directly investing in a company that possesses the technology? Each of these present differing degrees of corporate intimacy between the parties, and each presents its own opportunities and pitfalls. In short, the choice is not between buying shares or not, but in deciding from among the various degrees of corporate intimacy with which that technology or opportunity can be obtained, if indeed it ought to be obtained. The present invention provides two quantitative measures by which this decision can be made in an objective manner: "usability", which is a compound measure of "product performance characteristics, user friendliness, aesthetic qualities and readiness for market; and "appropriability", which is defined in terms of vendor and product positioning within the marketplace and related factors. (See paragraph 27 of the disclosure). Scalar quantities based on these compound measures are then plotted on a graph to generate a decision matrix through which decision makers are advised on the level of intimacy appropriate for the given opportunity (i.e., to invest, partner, adopt or ignore).

Independent claims 1, 22, and 43 have been amended to more clearly set forth the role of "usability" and "appropriability" for providing information of use to the decision makers of an organization. Similar limitations were previously present singly in dependent claims 14 and 15. In rejecting those claims, the examiner took the position that Reese's use of a "smile" and "pain" index constituted first and second numerical characteristics as these were then being claimed. The undersigned respectfully avers that they do not.

In Reese, "smiles and pain" fundamentally measure whether a source of advice is worth listening to, i.e., whether doing so would've made the investor money in the past. Where it would have, the recommender is given a rating on a so-called "smile index" and where it would not have, the recommender is given a rating on a so-called "pain index". These terms are defined in the patent thusly:

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> Pain Index: A proprietary index that attempts to
> numerically describe the stress sand unpleasantness if you
> had followed a recommendation. E.g. .... the price of
> [shares of stock in] Zoltek fell to $50 on Tuesday, $48 on
> Wednesday, $46 on Thursday or $40 one month later.
> (Column 5, lines 42 – 47)

> Smile Index: A proprietary index that attempts to
> numerically describe the pleasantness of each of the
> recommendations .... E.g. .... the price of [shares of stock
> in] Zoltek rises to $55 on Tuesday, $58 on Wednesday,
> $60 on Thursday or $70 one month later. (Column 6, lines
> 56 – 61)

Clearly, while two terms are being used here, they are addressing the same, uni-dimensional question: would the outcome of listening to this recommendation have been profitable ("smile"), or would it have cost one money ("pain')?

As noted above, the present invention addresses fundamentally different sorts of questions that are not expressible as simple "buy" or "sell" recommendations, and which are not amenable to Reese's simple linear "smile – pain" view of stock recommendations. The invention set forth in the claims is not directed to the needs of investors who simply want to make money buying or selling stocks. Rather, it is directed to the needs of high level decision makers who are contemplating acquiring a new technology or pursuing a new enterprise for the sake of the business as a whole. This entails a multidimensional decision making process that requires the use of parameters (including joint measures of usability and appropriability) not contemplated by Reese et al., who don't present the same answers in part because they don't even address the same questions.

For at least the above reasons, it is respectfully submitted that claims are patentable over Reese et al. and should be allowed.

5. **Rejection of Claims 21 and 42 under 35 USC §103(a)**

Claims 21 and 42 stand rejected under 35 USC §103(a) over Reese. The Applicants respectfully traverse this rejection and its supporting remarks.

As noted above, independent claims 1 and 22 presently are patentable over Reese. Furthermore, these claims recite a decision matrix on which are expressed

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recommendations to adopt, partner, invest, or ignore an opportunity. Reese, in contrast (Figure 8c) merely shows a chart on which a "pick". or "pan" recommendation is presented in one column of information. There simply is no multidimensional matrix of possibilities as is set forth in the claims.

For at least these additional reasons, it is respectfully submitted that claims 21 and 42 are patentable over Reese.

Applicants submit that the claims of the present invention are in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicant's attorney at (908) 518-7700 to resolve any outstanding issues.

The Office is authorized any required fees to deposit account number 50-1047.

Respectfully submitted,

James Prizant
Registration No. 34,067

Attorney for Applicant
Mayer Fortkort & Williams, PC
251 North Avenue West, 2nd Floor
Westfield, NJ 07090
Tel.: 908-518-7700
Fax: 908-518-7795

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